UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,220	12/11/2000	Marc W. Kauffman	D02487	5436

43471	7590	02/23/2006		EXAMINER

GENERAL INSTRUMENT CORPORATION DBA THE CONNECTED
HOME SOLUTIONS BUSINESS OF MOTOROLA, INC.
101 TOURNAMENT DRIVE
HORSHAM, PA 19044

DUONG, THOMAS

ART UNIT	PAPER NUMBER
2145	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/734,220	KAUFFMAN ET AL.
	Examiner	Art Unit	
	Thomas Duong	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 November 2005</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-30</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This office action is in response to the applicants Amendment filed on November 18,

2005. *Claims 1-30* are presented for further consideration and examination.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

3.   *Claims 1-30* are rejected under 35 U.S.C. 102(e) as being anticipated by Capek et al.

(US006094677A).

4.   With regard to *claims 1 and 21*, Capek discloses,

- *a first cache (insertion repository 22) for storing a received alternative media file;*

     (Capek, col.7, lines 17-25, lines 39-47; module 22, fig.2)

     Capek teaches of an insertion repository that stores data (multimedia,

     advertisements, announcements, etc.) to be inserted in the data stream delivered

     to the requested client.

- *a second cache (server 26) for storing a streaming multimedia file;* (Capek, col.7, lines 17-25; module 26, fig.2)

  Capek teaches of a server that stores data (multimedia, program material, etc.) to be delivered to the requested client.

- *a control unit (insertion manager 20) for receiving as a first input a control signal from said first cache and generating as an output a switching control signal indicative of the presence or absence of a complete alternative media file being stored in said first cache; and* (Capek, col.7, lines 17-25, lines 39-47; module 20, fig.2)

  Capek teaches of an insertion manager that inserts data (multimedia, advertisements, announcements, etc.) to be delivered to the requested client.

- *a switching mechanism, coupled to each one of said control unit, said first cache, said second cache and said streaming multimedia file for providing as an output, directed to the at least one end-user, a stream selected from one of said first cache, said streaming multimedia file and said second cache, as controlled by said switching output signal from said control unit so as to insert the alternative media file in the stream* (Capek, col.5, lines 20-22; col.7, lines 49-52; col.9, lines 6-24; col.10, lines 18-28)

  Capek includes a control mechanism that *"will provide for the replacement of the insertion by the requested program material once the program material is received from the distribution server"* (Capek, col.9, lines 11-13). In other words, Capek's control mechanism will replace the insertion data, which may be *"text, graphics, animation, motion video, sound, etc"* as well as *"the combination of data having different formats into a single insertion for providing a multimedia*

experience" (Capek, col.7, lines 49-52), with the requested material once it is

available. According to Capek, the control logic's function is to *"replaces the*

insertion with the requested program material after the program is retrieved"

(Capek, col.5, lines 20-22). Also, the *"insertion manager may then make a*

determination of how long to provide the insertion to the user before beginning to

forward the buffered data to the client in order that the last byte of data is

delivered at approximately the same time as it would have been if the data had

been downloaded directly to the client" (Capek, col.10, lines 18-27).

- *wherein the alternative media file is inserted in the stream independent of*

  boundaries of the multimedia file. (Capek, col.5, lines 20-22, lines 41-52; col.7,

  lines 49-52; col.9, lines 6-24; col.10, lines 18-28; col.10, lines 1-67)

  Capek includes a control mechanism that *"will provide for the replacement of the*

  insertion by the requested program material once the program material is

  received from the distribution server" (Capek, col.9, lines 11-13). In other words,

  Capek's control mechanism will replace the insertion data, which may be *"text,*

  graphics, animation, motion video, sound, etc" as well as *"the combination of*

  data having different formats into a single insertion for providing a multimedia

  experience" (Capek, col.7, lines 49-52), with the requested material once it is

  available. According to Capek, the control logic's function is to *"replaces the*

  insertion with the requested program material after the program is retrieved"

  (Capek, col.5, lines 20-22). Also, the *"insertion manager may then make a*

  determination of how long to provide the insertion to the user before beginning to

  forward the buffered data to the client in order that the last byte of data is

  delivered at approximately the same time as it would have been if the data had

been downloaded directly to the client" (Capek, col.10, lines 18-27). In addition,

Capek teaches *"wherein an insertion is selectively transmitted to the first*

application if the amount of time required to retrieve the requested information is

sufficient to transmit the insertion to the first application. The transmission of the

retrieved application may, on the other hand, be preceded by waiting a

preselected period of time. The preselected period of time may be based upon

the insertion transmitted to the first application. The preselected period of time

may alternatively be based upon the amount of time required to retrieve the

information from the second computer" (Capek, col.5, lines 41-52). Hence,

Capek teaches of inserting the alternate media file into the multimedia stream

regardless of the stream since the insertion, as *"a complete insertion or elements*

of an insertion that can be used to generate a complete insertion dynamically"

(Capek, col.5, lines 14-16) can be done while waiting for the retrieval of

requested stream (i.e. during a network delay in the middle of transmitting the

multimedia perhaps), before the transmission of the multimedia altogether, etc.

5.   With regard to <u>claim 2</u>, Capek discloses,

- *a first cache (insertion repository 22) for storing a received alternative media file;*
  (Capek, col.7, lines 17-25, lines 39-47; module 22, fig.2)
  Capek teaches of an insertion repository that stores data (multimedia,
  advertisements, announcements, etc.) to be inserted in the data stream delivered
  to the requested client.

- *a second cache (server 26) for storing a streaming multimedia file;* (Capek, col.7,
  lines 17-25; module 26, fig.2)

Capek teaches of a server that stores data (multimedia, program material, etc.) to be delivered to the requested client.

- *a control unit (insertion manager 20) for receiving as a first input a control signal from said first cache and generating as an output a switching control signal indicative of the presence or absence of a complete alternative media file being stored in said first cache; and* (Capek, col.7, lines 17-25, lines 39-47; module 20, fig.2)

Capek teaches of an insertion manager that inserts data (multimedia, advertisements, announcements, etc.) to be delivered to the requested client.

- *a switching mechanism, coupled to each one of said control unit, said first cache, said second cache and said streaming multimedia file for providing as an output, directed to the at least one end-user, a stream selected from one of said first cache, said streaming multimedia file and said second cache, as controlled by said switching output signal from said control unit so as to insert the alternative media file at a predetermined location in the stream, including either one of the beginning and the end of the streaming multimedia file,* (Capek, col.5, lines 20-22, lines 41-52; col.7, lines 49-52; col.9, lines 6-24; col.10, lines 18-28; col.10, lines 1-67)

Capek includes a control mechanism that *"will provide for the replacement of the insertion by the requested program material once the program material is received from the distribution server"* (Capek, col.9, lines 11-13). In other words, Capek's control mechanism will replace the insertion data, which may be *"text, graphics, animation, motion video, sound, etc"* as well as *"the combination of data having different formats into a single insertion for providing a multimedia*

experience" (Capek, col.7, lines 49-52), with the requested material once it is

available. According to Capek, the control logic's function is to *"replaces the*

insertion with the requested program material after the program is retrieved"

(Capek, col.5, lines 20-22). Also, the *"insertion manager may then make a*

determination of how long to provide the insertion to the user before beginning to

forward the buffered data to the client in order that the last byte of data is

delivered at approximately the same time as it would have been if the data had

been downloaded directly to the client" (Capek, col.10, lines 18-27). In addition,

Capek teaches *"wherein an insertion is selectively transmitted to the first*

application if the amount of time required to retrieve the requested information is

sufficient to transmit the insertion to the first application. The transmission of the

retrieved application may, on the other hand, be preceded by waiting a

preselected period of time. The preselected period of time may be based upon

the insertion transmitted to the first application. The preselected period of time

may alternatively be based upon the amount of time required to retrieve the

information from the second computer" (Capek, col.5, lines 41-52). Hence,

Capek teaches of inserting the alternate media file into the multimedia stream

regardless of the stream since the insertion, as *"a complete insertion or elements*

of an insertion that can be used to generate a complete insertion dynamically"

(Capek, col.5, lines 14-16) can be done while waiting for the retrieval of

requested stream (i.e. during a network delay in the middle of transmitting the

multimedia perhaps), before the transmission of the multimedia altogether, etc.

- *wherein the control signal output from the first cache indicates that a complete*

  alternative file is stored and is ready for transmission to the predetermined at

least one end-user, or will be ready in time to transmit. (Capek, col.7, lines 17-25,

lines 39-47)

Capek teaches of complete insertions of data to be delivered to the requested

client.

6.   With regard to *claims 3 and 22-23*, Capek discloses,

*   *wherein the control signal output from the first cache indicates that a complete*

    alternative file is stored and is ready for transmission to the predetermined at

    least one end-user. or will be ready in time to transmit. (Capek, col.7, lines 17-25,

    lines 39-47)

    Capek teaches of complete insertions of data to be delivered to the requested

    client.

7.   With regard to *claims 4-9*, Capek discloses,

*   *wherein the switching mechanism supplies as an output the streaming*

    multimedia file in the absence of a signal from the control unit that an alternative

    file is ready to transmit. (Capek, col.9, lines 6-24)

    Capek teaches of a control mechanism that interacts with and control the

    insertion of data (multimedia, advertisements, announcements, etc.) delivered to

    the requested client.

8.   With regard to *claims 10-11*, Capek discloses,

*   *wherein the alternative file is defined as an advertisement file.* (Capek, col.7,

    lines 17-25, lines 39-47; col.7, line 66 – col.8, line 10; col.8, lines 11-14)

Capek teaches of an insertion repository that stores data (multimedia,

advertisements, announcements, etc.) to be inserted in the data stream delivered

to the requested client.

9.   With regard to *claims 12-20*, Capek discloses,

  - *wherein the arrangement is disposed at a local point of presence in a*

    communication network. (Capek, col.7, lines 26-37)

10.   With regard to *claims 24-30*, Capek discloses,

  - *wherein in performing step d), switching from said streaming multimedia file to*

    said alternative file when recognizing that an alternative file is available. (Capek,

    col.9, lines 6-24)

    Capek teaches of a control mechanism that interacts with and control the

    insertion of data (multimedia, advertisements, announcements, etc.) delivered to

    the requested client.

Response to Arguments

11.   Applicant's arguments with respect to *claims 1-30* have been considered but they are not

persuasive.

12.   With regard to *claims 1, 2, and 21*, the Applicants point out that:

  - *As explained in Applicant's prior response filed on July 5, 2005, Capek does not*

    disclose or suggest inserting an alternative media file into a streaming multimedia

    file using a first and second cache, a control unit, and a switching mechanism,

wherein the alternative media file is inserted in the stream independent of

boundaries of the multimedia file, as substantially recited by Amended claims 1

and 21. Capek discloses to provide an insert during a delay of receiving

requested data. Abs.; Figs. 4A and 4B. Capek discloses to maintain an insertion

repository 22 which provides inserts to insertion manager 20, at which point

insertions are made in a delay period. Fig. 2. Capek discloses to determine if an

insert should be provided based on the sufficiency of the delay period, which may

be determined by the actual delay seen or an expected delay based on historical

information. Col. 10: 52-68; and col. 11: 61 - col. 12: 24. Once the data is

retrieved it is provided after the insert, i.e. when the insert is selectively provided

with the data, the insert is provided at the beginning of the data - during the delay

in retrieving the data. Figs. 3-7; col. 10: 29-5 1; col. 12: 47-55. Capek does not

disclose or suggest inserting an alternative media file into a streaming multimedia

file using a first and second cache, a control unit, and a switching mechanism,

wherein the alternative media file is inserted in the stream independent of

boundaries of the multimedia file.

However, the Examiner finds that the Applicants' arguments are not persuasive

because Capek anticipates that *"other functionality that may be provided by the*

control mechanism include the dismissal of a particular insertion or the

discontinuance of insertions in general" (Capek, col.9, lines 13-16). Hence, it is clear

that Capek anticipates of a situation where the insertion manager interrupts or

ceases the insertion in order to deliver the requested material to the user. In

addition, according to Capek, *"as evident from FIG. 4A, the client experiences a*

delay from time A through at least time F, and possibly through time I. During the

interval from time F to time I, the user may be presented with results depending upon

the specific technology and specific content for the particular instance" (Capek,

col.10, lines 47-51). Capek also states that *"the client is presented with the insertion*

from at least time Z through time F, and perhaps from time X through time I, again

depending upon the specific content and technology" (Capek, col.10, lines 64-67).

Hence, Capek anticipates that, during periods of delay in transferring the requested

material to the user, the insertion manager may make determinations to deliver

inserts of alternative data to the user.

Therefore, the Applicants still failed to clearly disclose the novelty of the invention

and identify specific limitation, which would define patentable distinction over prior

art.

Conclusion

13.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as

set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is

set to expire THREE MONTHS from the mailing date of this action. In the event a first

reply is filed within TWO MONTHS of the mailing date of this final action and the

advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

from the mailing date of the advisory action. In no event, however, will the statutory

period for reply expire later than SIX MONTHS from the date of this final action.

14.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Thomas Duong whose telephone number is 571/272-3911. The

examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the

examiner by telephone are unsuccessful, the examiner's supervisor, Jason D. Cardone

can be reached on 571/272-3933. The fax phone numbers for the organization where

this application or proceeding is assigned are 571/273-8300 for regular communications

and 571/273-8300 for After Final communications.

Thomas Duong (AU2145)

February 16, 2006

Jason D. Cardone

Supervisory PE (AU2145)